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OCT 30 2002  
TECH CENTER 1600/2900  
Patent  
Attorney's Docket No. 003300-581

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of )  
Thomas BRODIN *et al.* ) Group Art Unit: 1627  
Application No.: 09/365,241 ) Examiner: Padmashri Ponnaluri  
Filed: July 30, 1999 ) Confirmation No.: 1539  
For: *IN SITU* IDENTIFICATION OF )  
TARGET STRUCTURES E.G. *IN* )  
*VIVO* SELECTION METHOD FOR A )  
PHAGE LIBRARY (AS AMENDED) )

*P. TUCK*  
*#28*  
*11/5/02*

**REPLY TO ELECTION REQUIREMENT**

Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

This paper responds to the Election Requirement dated October 8, 2002 (Paper No. 27) in connection with the above-identified application. This response is timely filed.

Applicants hereby elect, albeit with traverse, the species of antibody-identifying sequence information of nucleic acid.

M.P.E.P. § 803 states that an application may be properly restricted to one or more claimed inventions only if 1) the inventions are independent or distinct as claimed, and 2) there is a serious burden on the Examiner if the restriction is not required. Thus, even if appropriate reasons exist for requiring restriction, such a restriction should not be made unless there is an undue burden on the Examiner to examine all of the claims in a single application. Applicants respectfully assert that this species election is unwarranted. Specifically, for a restriction requirement under M.P.E.P. § 816 an explanation of species distinction and their mutual exclusivity (see M.P.E.P. § 806.04(f)) must be provided along with an explanation of why the burden is undue. Applicants respectfully submit that no showing has been made as required by the M.P.E.P. (either in the present Office Action or

in the previous Office Action), but rather the Examiner merely states that a species must be elected.

Applicants further submit that under M.P.E.P. § 804(f), claims restricted to different species must be mutually exclusive. The present generic claim is a method claim which recites steps which are employed with both species named by the Examiner, therefore, they are not mutually exclusive. Applicants emphasize that the presently claimed invention is a screening process in which the same steps are employed to practice regardless of the type of antibody-identifying sequence information. The method steps utilizing either species are the same and the same search is required regardless of type of antibody-identifying sequence information. The claimed method centers on the use of the selection process, not type of antibody-identifying sequence information. Electing a particular species here adds another layer of unnecessary complexity which adds to the search burden, it does not ease it. Accordingly, Applicants respectfully submit that this category should be eliminated.

Applicants do not elect a single monoclonal antibody as requested in the election requirement because one cannot be elected due to the nature of the invention. Applicants' undersigned representative conducted a telephone conference with Examiner Ponnaluri concerning this issue on October 17, 2002. During this conversation, it was established that the presently claimed invention is directed to a screening method using, *inter alia*, a monoclonal antibody library. Accordingly, a single monoclonal antibody cannot be elected for purposes of searching and examining the presently claimed invention. The Examiner agreed with this assessment and indicated that the election requirement was based on a misunderstanding of the claim language. Applicants' undersigned representative was informed by the Examiner that a single species for this requirement did not need to be elected.

Thus, for at least all of the reasons set forth above, withdrawal of the requirement for election of species is requested and believed to be in order. Further and favorable consideration of all the claims of record on the merits is respectfully requested.

In the event that the Examiner has any outstanding issues, she is invited to contact Applicants' undersigned representative at her convenience.

Respectfully submitted,  
BURNS, DOANE, SWECKER & MATHIS, L.L.P.

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Date: October 28, 2002



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Attorney's Docket No. 803300-58

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of	)	
Thomas BRODIN <i>et al.</i>	)	Group Art Unit: 1627
Application No.: 09/365,241	)	Examiner: Padmashri Ponnaluri
Filed: July 30, 1999	)	Confirmation No.: 1539
For: <i>IN SITU</i> IDENTIFICATION OF	)	
TARGET STRUCTURES E.G. <i>IN VIVO</i>	)	
SELECTION METHOD FOR A PHAGE	)	
LIBRARY (AS AMENDED)	)	

REPLY TO ELECTION REQUIREMENT TRANSMITTAL LETTER

Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

Enclosed is a Reply to Election Requirement for the above-identified patent application.

- ☐ A Petition for Extension of Time is also enclosed.
- ☐ A Terminal Disclaimer and a check for ☐ \$55.00 (2814) ☐ \$110.00 (1814) to cover the requisite Government fee are also enclosed.
- ☐ Also enclosed is \_\_\_\_\_
- ☒ Small entity status is hereby claimed.
- ☐ Applicant(s) request continued examination under 37 C.F.R. § 1.114 and enclose the ☐ \$370.00 (2801) ☐ \$740.00 (1801) fee due under 37 C.F.R. § 1.17(e).
- ☐ Applicant(s) previously submitted \_\_, on \_\_, for which continued examination is requested.
- ☐ Applicant(s) request suspension of action by the Office until at least \_\_, which does not exceed three months from the filing of this RCE, in accordance with 37 C.F.R. § 1.103(c). The required fee under 37 C.F.R. § 1.17(i) is enclosed.
- ☐ A Request for Entry and Consideration of Submission under 37 C.F.R. § 1.129(a) (146/246) is also enclosed.
- ☒ No additional claim fee is required.

Reply To Election Requirement Transmittal Letter

Application Serial No. 09/365,241

Attorney's Docket No. 003300-581

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☐ An additional claim fee is required, and is calculated as shown below:

AMENDED CLAIMS					
	NO. OF CLAIMS	HIGHEST NO. OF CLAIMS PREVIOUSLY PAID FOR	EXTRA CLAIMS	RATE	ADDT'L FEE
Total Claims	33	MINUS 53 =	-0-	× \$18.00 (1202) =	-0-
Independent Claims	1	MINUS 3 =	-0-	× \$84.00 (1201) =	-0-
If Amendment adds multiple dependent claims, add \$280.00 (1203)					
Total Amendment Fee					
If small entity status is claimed, subtract 50% of Total Amendment Fee					
TOTAL ADDITIONAL FEE DUE FOR THIS AMENDMENT					-0-

☐ A claim fee in the amount of \$\_\_\_\_\_ is enclosed.

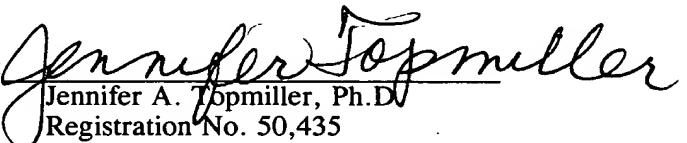
☐ Charge \$\_\_\_\_\_ to Deposit Account No. 02-4800.

The Commissioner is hereby authorized to charge any appropriate fees under 37 C.F.R.

§§ 1.16, 1.17, 1.20(d) and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 02-4800. This paper is submitted in duplicate.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

By:   
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